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IN THE

Supreme Court of the United States

OCTOBER TERM, 1965

No. 1092

UNIVERSAL MARION CORPORATION,

Petitioner,

vs.

THE WARNER & SWASEY COMPANY, et al.,

Respondents.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE TENTH CIRCUIT

ROBERT MCKAY,
Attorney for Petitioner,
330 Madison Avenue,
New York, N. Y. 10017.

Of Counsel:
PENNIE, EDMONDS, MORTON,
TAYLOR AND ADAMS,
New York, New York.
HARRY C. JONES, III,
New York, New York.

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PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE TENTH CIRCUIT

Petitioner, Universal Marion Corporation, prays that a Writ of Certiorari issue to review the judgment of the United States Court of Appeals for the Tenth Circuit in the above-entitled patent infringement action.*

Opinions Below

The Opinion of the Court of Appeals is reported at 354 F. 2d 541 and is reprinted at pages 2a-9a.** The opinion of the District Court of Colorado is reported at 237 F. Supp. 719 and is reprinted at pages 11a-63a.

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* The respondents are: The Warner & Swasey Company; Ray Ferwerda; Sophia Louise Ferwerda, individually and as Guardian for Frederick Martin Ferwerda; Alice Rose Olsen; Sophia Louise Rebell; Raymond Koop Ferwerda; and Frederick Martin Ferwerda; by his Guardian Sophia Louise Ferwerda.

** References to the Appendix filed herewith are by page number followed by the letter "a".

Jurisdiction

The judgment of the Court of Appeals was entered on December 30, 1965 (p. 10a). The jurisdiction of this Court is invoked pursuant to 28 U. S. C. Sec. 1254(1). The basis of jurisdiction in the District Court was 28 U. S. C. Sec. 1338(a) and Sec. 1400(b).

The Questions Presented

I. Are the legal criteria expressed by this Court in 1877 in *Elizabeth* v. *Pavement Co.*[1] for distinguishing an invalidating prior public use defense from a non-invalidating experimental use appropriate today for determining whether an admittedly nonsecretive, commercial exploitation of an invention more than one year prior to the filing of an application for patent should come within a judicially-created non-statutory exception to 35 U. S. C. § 102(b) which exception is contrary to express public policy forbidding patent monopolies except for "limited Times"?

II. Is the provision of 35 U. S. C. § 282 relating to the presumption of validity of a patent applicable to an affirmative defense attacking the validity on matters not examined by the Patent Office?

Constitutional Provisions and Statutes Involved

This case involves Article I, Section 8, Clause 8 of the Constitution and Sections 102(b) and 282 of Title 35 of the United States Code. These provisions are set forth at page 1a.

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[1] 97 U. S. 126 (1877).

Statement of Facts

The petitioner, Universal Marion Corporation, at the time of the filing of this action was engaged in the manufacture of a hydraulically operated earth moving machine known as the "Grademaster" used in digging ditches, sloping trenches and the like. It is this Grademaster machine which is alleged by respondents to infringe claims 6, 7, 8, 9 and 16 of Patent No. 2,541,045.

The respondent, Ray Ferwerda and his now deceased brother, Koop Ferwerda, are the patentees of the patent. They filed their application for patent on May 15, 1944 and the patent was subsequently granted on February 13, 1951. The patent will not expire until February 13, 1968. In 1946, the Ferwerda brothers granted the respondent, The Warner & Swasey Company, an exclusive license under their then pending patent application to make, use and sell machines which were the subject of the application and any patent issuing thereon.

The machine described in the patent and as shown in Fig. 1 of the patent, reproduced at page 67a, is an earth moving machine which has a movable telescoping boom on the free end of which different implements, such as a scraper blade or bucket, may be mounted in order that the machine may be used for sloping trenches, digging ditches, etc. The boom is pivotally carried near one of its ends on a turntable which is mounted on a truck body. Rotation of the turntable swings or slues the boom in a horizontal plane and movement of the boom about its pivot raises and lowers the free end of the boom in a vertical plane. The boom is also mounted for rotation about its own longitudinal axis and includes an extensible section telescopically received within a base section. The implement for performing working operations is carried at the free end of the boom and pivotally attached for movement relative to the end of the boom in a hinge-like manner.

The movements of the boom plus the hinge movement of the implement together give the implement five degrees of movement: (1) swinging in a horizontal plane, (2) raising and lowering in a vertical plane, (3) rotation about the longitudinal axis of the boom, (4) extension and retraction with the free end of the boom, and (5) pivoting on the end of the boom. Structure is described in the patent for effectuating all of the movements.

All the claims in suit describe the machine as a combination of elements wherein each element is defined in broad terms. For example, see claim 6 (p. 68a).

In 1943, the Ferwerda brothers owned a contracting company which together with other contracting companies was engaged in the construction for the United States Government of the Ravenna Munitions Arsenal at Ravenna, Ohio. Among the machines used by the Ferwerdas at this project was a hydraulically operated earth moving machine that would later be called by the Ferwerda brothers as the "Gradall" machine. The machine used at Ravenna is pictured at page 69a. Petitioners assert that the use of this machine at Ravenna was a prior public use of the invention under 35 U. S. C. § 102 (b) while respondents assert that the use was experimental and thus not a defense under the statute.

The Ravenna machine is described in a mimeographed statement (pp. 70a-71a) distributed by the Ferdwerda brothers long before this action arose as being put to work in 1943 "as soon as the frost disappeared" which was "In the middle of March . . . ". This statement goes on to state that other contractors, engineers, and inspectors who visited the project had complimented the Ferwerdas on the machine and the quality of the work which it performed, and concludes by stating that if the ". . . Gradall had not been there, it would have been impossible to complete that project during that period." The statement contains no mention or suggestion that the machine was operated for

any test purposes or for any purpose other than for completing the project.

Only *two* changes were made to the machine during the time it was operated at the Ravenna project. Specifically, a brace was added ". . . in order to make the structure more solid" (R 157)*, and the position of the hydraulic lifting cylinder used to raise and lower the boom as shown on the top of the machine at page 69a, was changed in order to reduce the overall height of the machine (R 158). Neither of these changes is described in the patent claims.

This very same Ravenna machine was further used after the grading project at Ravenna was completed on other contracted grading projects in Pennsylvania without any further change being made to its structure (p. 65a).

In contrast to the plain import of the mimeographed statement that the Ravenna machine was successful and performed its job satisfactorily, Mr. Ray Ferwerda testified much later at the trial that "we found this [Ravenna] machine not satisfactory or marketable, we started to think, and we re-engineered a different machine, which we thought was better" and that it took approximately six months to re-engineer the machine (p. 64a).

It is this re-engineered machine which is pictured in the patent and at page 67a. The re-engineering resulted in only minor mechanical changes.

After re-engineering the machine, the Ferwerda brothers then waited until May 15, 1944 before filing their application for patent which was more than a year after they had first used the Ravenna machine on the construction project at the Ravenna Munitions Arsenal.

The District Court, as affirmed by the Court of Appeals, found that the operation of the Ravenna machine was a

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* References to the printed Transcript of Record are by the letter "R" followed by the page number.

"limited use" of the "invention" more than a year prior to the filing of the application for patent although it concluded that such use was experimental (p. 44a).

Reasons for Granting the Writ

As to Question One

This Court has recently stated with regard to the Patent Act that:

> "Within the limits of the constitutional grant, the Congress may, of course, implement the stated purpose of the Framers by selecting the policy which in its judgment best effectuates the constitutional aim."[2]

The purpose of the framers as appears in Article I, Section 8, Clause 8, of the Constitution is that:

> "The Congress shall have the Power . . .
>
> . . . . .
>
> To promote the Progress of Science and the Arts, by securing for *limited Times* to . . . Inventors, the exclusive Right to their . . . Discoveries . . ."(Emphasis added.)

Congress in implementing the purpose of the framers enacted 35 U. S. C. § 102(b) which is quite specific. It provides:

> "A person shall be entitled to a patent unless . . . (b) the invention was . . . in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, . . ."

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[2] Graham v. John Deere Co., —— U. S. —— (February 21, 1966).

Prior use prohibitions have been continuously included in the patent laws of this country since 1790.[3]

One of the more cogent reasons given for the inclusion of the prior use provisions in the patent statutes is that made by Mr. Justice Story in *Pennock* v. *Dialogue*, 27 U. S. 1 (1829). While the statement was with reference to the Patent Act of 1793, its reasonings hold true today with respect to the present Act. Mr. Justice Story stated:

> "We think, then the true meaning must be, not known or used by the public, before the application. And thus construed, there is much reason for the limitation thus imposed by the Act. While one great object was, by holding out a reasonable reward to inventors, and giving them an exclusive right to their inventions for a limited period, to stimulate the efforts of genius; the main object was 'to promote the prog-

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[3] The Patent Act of 1790, 1 Stat. 109, provided that a person was entitled to a patent if, among other things, his petition recited that the subject matter for which the patent was sought "was not before known or used".

The Patent Act of 1793, 1 Stat. 318, changed the requirement of prior use such that the petition had to recite that the subject matter of the patent was "not known or used before the application".

§ 6 of the Patent Act of 1836, 5 Stat. 117, for the first time made the absence of a prior "public" use a condition of patentability. It required that the subject matter to be patented by the inventor should not be "at the time of his application for patent, in public use or on sale, . . .".

§ 7 of the Patent Act of 1839, 5 Stat. 353, provided a grace period of two years prior to the filing of the application during which time the subject matter of the patent could be used without voiding the patent.

§ 24 of the Patent Act of 1870, 16 Stat. 198 (later § 4886 of the Revised Statutes), provided that a person might obtain a patent on his invention provided that it was "not in public use or on sale more than two years prior to his application . . .".

§ 1 of the Act of 1939, 53 Stat. 1212, reduced the grace period to one year which has been carried over to the present statute.

> ress of science and useful arts;' and this could be done best, by giving the public at large a right to make, construct, use and vend the thing invented, at as early a period as possible, having a due regard to the rights of the inventor. If an inventor should be permitted to hold back from the knowledge of the public the secrets of his invention; if he should, for a long period of years, retain the monopoly, and make and sell his invention publicly, and thus gather the whole profits of it, relying upon his superior skill and knowledge of the structure; and then, and then only, when the danger of competition should force him to secure the exclusive right, he should be allowed to take out a patent, and thus exclude the public from any further use than what should be derived under it, during his fourteen years; it would materially retard the progress of science and the useful arts, and give a premium to those who should be least prompt to communicate their discoveries" (p. 18).

Despite the specific language respecting the "public use" prohibitions contained in the various statutes, this Court created a judicial exception to the public use language when it stated in *Elizabeth* v. *Pavement Co., supra*, that "good faith" testing of an invention was not a public use even though the operation of the invention may have been nonsecretive. A number of guide lines are suggested in *Elizabeth* by which a "public use" may be distinguished from a nonsecretive use for experimental purposes. Among the guide lines mentioned are the "object and purpose" of the use that the inventor had in view, whether the object and purpose was corroborated by other witnesses, whether the actual use of the *invention* was a "good faith" testing of the *invention*, whether durability was a factor to be tested, whether the *invention* remained in the control of the inventor, and whether there was affirmative evidence

of an intent not to abandon rights in an invention such as by the filing of a caveat* with the Patent Office.

A number of these guides by their very nature are subjective and when applied to a particular set of facts, may result in different conclusions being reached by different courts. While this Court has applied the guide lines set out in *Elizabeth* strictly, the lower courts have not. In *every* case in which this Court has cited *Elizabeth* for the proposition that an experimental use is not necessarily a public use, it has found a prior public use invalidating a patent.[4] To the contrary, there are many lower court decisions holding patents valid where there has been proven prior nonsecretive use on the grounds that such use was experimental and thus within the holding of the *Elizabeth* case to the extent that *Elizabeth* has become a well-worn life preserver stretched to fill a variety of factual circumstances differing from those that existed in *Elizabeth.*[5]

In *Electric Battery Co.* v. *Shimadzu, supra,* at page 20, this Court stated, "Mere experimental use is not the public use defined by the Act, [citing *Elizabeth*], *but a single use for profit, not purposely hidden, is such.*" (Emphasis added.) thus indicating that there might be a still further objective commercial guide line which can be used in distinguishing a public use from an experimental use. That

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* A document ". . . praying protection of his [inventor's] right till he shall have matured his invention, . . ." Patent Act of 1836, 5 Stat. 117, § 12. Caveats were abolished by the Act of 1910, 36 Stat. 843, Chap. 414.

[4] *Egbert* v. *Lippmann,* 104 U. S. 333 (1881); *Smith & Griggs Mfg. Co.* v. *Sprague,* 123 U. S. 249 (1887); *International Tooth Crown Co.* v. *Gaylord,* 140 U. S. 55 (1891); *Root* v. *Third Avenue Railroad,* 146 U. S. 210 (1892); *Electric Battery Co.* v. *Shimadzu,* 307 U. S. 5 (1939).

[5] Of the approximately one hundred reported decisions citing *Elizabeth* for this proposition, more than one half have found excusable experimental use.

case is the last in which this Court has considered "public use".

Some Courts of Appeals recently have been applying a more objective test for ascertaining whether there was any commercial use, secretive or nonsecretive, of an invention, and, if finding that there was any competitive exploitation of the *invention*, holding it to act as a *forfeiture* of any patent rights under § 102(b). This approach is expressed by Judge Learned Hand in *Metallizing Engineer Co.* v. *Kenyon Bearing & A. P. Co.*, 153 F. 2d 516 (2 Cir. 1946), *cert. denied*, 328 U. S. 840 (1946). The Third Circuit Court of Appeals has also followed this approach and has specifically followed *Metallizing*. In *U. S. Chemical Corp.* v. *Plastics Glass Corp.*, 243 F. 2d 892 (3 Cir. 1957), *cert. denied*, 357 U. S. 836 (1957) that Court stated:

> "The issue is what is a public use or sale within the purview of the statute. This question was cogently discussed by Judge Learned Hand in the Metallizing Engineering Co. case, supra. We can add little of value to what Judge Hand said in the cited decision. We are in accord with what he stated. We sum up the application of the principle to the case at bar by saying that where, as here a patentee has used the process of a patent to create a product which has been sold on the market more than one year prior to the patent application, such use of the process and sales constitute 'prior use' within the meaning of Section 102(b), 35 U. S. C. *We are of the opinion that the patentee cannot avoid the impact of the statute by asserting that the sales were experimental to determine 'production controls'*, at least under the circumstances at bar. We cannot but conclude that the application of such a theory here would lead to an unwarranted extension of the patent monopoly." (p. 894, Emphasis added.)

The Sixth Court of Appeals has also followed this competitive exploitation approach.[6]

In the present case, there is no doubt that the invention of the patent was used more than a year prior to the filing of the application. The District Court so found. There is no doubt that the invention used was complete. The machine incorporating the invention performed the functions for which it was designed in that "if our Gradall had not been there [Ravenna], it would have been impossible to complete that project during that period" (p. 71a), and further, in that this same Ravenna machine was used on other grading projects without any further structural changes being made (p. 65a). There is no doubt that the use of the machine was nonsecretive. Other "contractors who visited the [Ravenna] project, complimented us on our machine and the quality of work performed" (p. 71a). There is no doubt that the inventors received monetary benefit from the use of their machine at Ravenna. The company which they owned had a contract to perform the grading operations (R 163).

Since the District Court did find a limited use of the invention more than one year prior to the filing of the patent application, the burden of going forward with the evidence should have shifted to respondents, requiring them to show by "full, unequivocal and convincing" evidence that such use was experimental, *Smith & Griggs Mfg. Co.* v. *Sprague, supra,* page 264. This respondents failed to do.

There *is* doubt as to the intent of the inventors in operating the machine at Ravenna and whether or not the operation was a "mere" experiment, *Electric Battery Co.* v. *Shimadzu, supra.* One inventor did testify twenty-one

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[6] *Huszar* v. *Cincinnati Chemical Works,* 172 F. 2d 6 (6 Cir. 1949).

years after the event that he tried the machine out at Ravenna. His testimony, unlike that of the inventor in the *Elizabeth* case, is not corroborated by any other witness. Such uncorroborated oral testimony made by an interested party many years after the event should, under the rationale expressed in *The Barbed Wire Patent*, 143 U. S. 275, 284 (1892), be given little weight in patent cases involving prior public use questions.

The District Court referred to changes made to the machine while at Ravenna and to the additional modifications made thereafter for supporting its holding that the use at Ravenna was experimental (p. 18a). If the changes and modifications are to be evidence in any sense that the prior use was for the purpose of experimentation, they must be of the type that change the character or operation of the earlier machine,[1] and be reflected in the *invention* defined by the claims of the patent subsequently applied for *after* the completion of the asserted experimentation. This they did not do and the District Court found the use of the machine at Ravenna was a use of the invention (p. 44a).

The District Court also referred to testimony by witnesses that a long period of time might be needed to test comparable machines (p. 18a). Such testimony is not directed to *the* machine as used at Ravenna and, more importantly, is not relevant to the invention defined in the claims. The invention as claimed, for example claim 6 (p. 68a), is to a combination of elements wherein each element is defined in broad terms. It does not take any extended period to test the function of the combination

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[1] *Smith & Griggs Mfg. Co.* v. *Sprague, supra; Eastman* v. *Mayor of City of New York*, 134 Fed. 844 (2 Cir. 1904); *Wendell* v. *American Laundry Machinery Co.*, 248 Fed. 698 (3 Cir. 1918); *National Biscuit Co.* v. *Crown Baking Co.*, 105 F. 2d 422, 427, 428 (1 Cir. 1939).

of elements as claimed. It may indeed be desirable to test the durability and strength of individual elements of a machine to obtain data on life expectancy, and it is expected that this type of testing would continue as long as a machine is in production.

> "That it was capable of improvement need not be denied, nor that, while it was in daily use, its owner and inventor watched it with the view of devising means to meet and overcome imperfections in its operation; but this much can be said in every such case. There are few machines, probably, which are not susceptible of further development and improvement, and the ingenuity of mechanics and inventors is commonly on the alert to discover defects and invent remedies. The alterations made in the machine in question, however useful, were not vital to its organization. Without them, it could and did work so as to be commercially successful." See *Smith & Griggs Mfg. Co. v. Sprague, supra,* page 265.

The District Court's findings in this case, as affirmed by the Court of Appeals, that the use of the machine at Ravenna was an experimental use of the invention rather than a public use fail to adhere to the guide lines for determining the judicial exception to public use as set out by this Court in the *Elizabeth* case, applied either strictly or liberally, or to the guide lines involved in any "competitive exploitation" test as advanced by the *Metallizing* case. The result is that respondents' patent is extended in time and petitioner as well as the public at large are prevented from using the invention at as early a period as possible.

The question of what is a "public use" is raised in many patent litigations and is believed next in importance to the question of obviousness in determining patentability of invention. This Court recently expressed its opinion re-

specting the latter,[8] and it is submitted that it should now do the same with respect to "public use" as the term is used in the Patent Act.

As to Question Two

The decision of both the Court of Appeals and the District Court misapplied the presumption of validity and the burden of proof provisions expressed in 35 U. S. C. § 282. Both courts have given the presumption of validity a substantive value which in some manner effectively increased the *degree* of proof required to invalidate a patent under the public use provisions of 35 U. S. C. § 102(b), and both courts have held that one attacking a patent does not even overcome this presumption of validity by establishing a prior nonsecretive use of the invention more than one year prior to the filing of an application for patent covering the invention. Specifically, the District Court found that "The defendant has failed to overcome the presumption of the patent's validity. . . . Defendant has sought to overcome the presumption of validity by attempting to show: that the patent was in 'public use' for more than one year prior to the application . . ." (pp. 43a-44a). The Court of Appeals affirmed (pp. 8a-9a).

This Court in discussing the presumption of validity to be given patents before the 1952 Act stated in *Mumm* v. *Decker & Sons*, 301 U. S. 168, 171 (1937) as follows:

> "For the grant of letters patent is *prima facie* evidence that the patentee is the *first inventor* of the device described in the letters patent and of its *novelty*. The issue of the patent is enough to show, *until the contrary appears*, that all the conditions under which a discovery is patentable in accordance with the statutes have been

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[8] *Graham* v. *John Deere Co.*, —— U. S. —— (February 21, 1966); *United States* v. *Adams*, —— U. S. —— (February 21, 1966).

met. Hence, the burden of proving want of novelty is upon him who avers it." (Emphasis added.)

Thus any substantive effect of the presumption of validity is restricted to matters examined by the Patent Office, namely the question of "first inventor" and "novelty", while procedurally the burden of proof of establishing invalidity with regard to all matters is placed upon the one attacking the patent. § 282 of the 1952 Patent Act has not changed this in any way as the declared intention of Congress in passing this section was to codify "the existing presumption of validity of patents".[9]

The District and Circuit Courts in the present case, however, have given the presumption of validity a substantive effect to matters not in any way *examined* by the Patent Office, namely prior use of the invention by the inventor, and have given this presumption undue weight throughout their consideration of the evidence regarding the nature of use of the invention.

Procedurally, the second sentence of § 282 places the burden of proof of prior public use on the one attacking the patent's validity. However, under *Smith & Griggs Mfg. Co.* v. *Sprague, supra,* this burden is completely met where a prior nonsecretive use of an invention within the prohibited period has been conclusively established. This condition has been met in this case as the District Court found a limited use of the invention during the prohibited period. At this point, the burden of going forward with the evidence should have shifted to the respondents if they are to avoid the effects of 35 U. S. C. § 102(b); and once shifted, the evidence presented to show that the use of the machine at Ravenna was a mere experiment must be full, unequivocal and convincing without regard to any presumption of validity. Where, as here, such evidence is not presented,

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[9] H. R. Rep. No. 1923, 82nd Cong. 2nd Sess. 29 (1952).

the patent must be held invalid under the provisions of § 102(b).

The presumption of validity and burden of proof provisions of § 282 involve important substantive and procedural considerations arising in substantially all patent litigations. It is submitted that the present case affords this Court an opportunity to correct the application made of § 282 by the District Court and the Court of Appeals and to make their own pronouncement as to the proper application of this section of the statute.

CONCLUSION

For the reasons stated, this Petition for Certiorari should be granted.

Respectfully submitted,

ROBERT MCKAY,
Attorney for Petitioner,
330 Madison Avenue,
New York, New York 10017.

Of Counsel:

PENNIE, EDMONDS, MORTON,
TAYLOR and ADAMS,
New York, New York.

HARRY C. JONES, III,
New York, New York.

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